THE OPINION ENTERED TODAY IS NOT BINDING PRECEDENT OF THE BOARD

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Paper No. 91

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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MINGCHIH M. TSENG

Junior Party
(Application 08/461,318)[1],

v.

SIAMAK DOROODIAN-SHOJA

Senior Party
(Patent No. 5,388,331).[2]

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Patent Interference No. 104,482

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Before SCHAFER, LEE and TORCZON, Administrative Patent Judges.

LEE, Administrative Patent Judge.

MEMORANDUM OPINION AND JUDGMENT

Introduction

On October 16, 2001, we issued a decision (Paper No. 85)

granting senior party Doroodian's preliminary motion 1 asserting no interference-in-fact and denying junior party Tseng's preliminary motion 1 to add more claims to its involved application. On the subject of interference-in-fact, we found that Doroodian had shown that its involved claims are patentably distinct from the involved claims of Tseng. Thus, parties Doroodian and Tseng do not claim the same patentable invention.

Neither party has requested reconsideration of our decision of October 16, 2001.

In our decision, we also ordered parties Doroodian and Tseng to brief the issue of whether, in light of our holding of no interference-in-fact, we should reach Tseng's preliminary motions 2-5 for judgment against Doroodian's involved patent claims. The parties have each filed a principal brief and a reply brief.

Findings of Fact

Numbered findings 1-22 are contained in our decision of October 16, 2001. In this opinion, we begin with numbered finding 23.

23. Tseng's preliminary motion 2 is for judgment against

24. Tseng's preliminary motion 3 is for judgment against Doroodian's patent claims 1-6 for indefiniteness under 35 U.S.C. § 112, second paragraph.

25. Tseng's preliminary motion 4 is for judgment against Doroodian's patent claims 1-6 under 35 U.S.C. § 112, first paragraph, for lack of written description in the specification.

26. Tseng's preliminary motion 5 for judgment against claims 1-6 of Doroodian's patent claims 1-6 as being unpatentable over prior art.

27. The prior art asserted by Tseng against Doroodian for anticipation under 35 U.S.C. § 102 are: (1) U.S. Patent No. 4,170,821 to Booth (against Doroodian's claim 1); (2) U.S. Patent No. 4,562,644 to Hitchens (against Doroodian's claims 1-4 and 6); (3) U.S. Patent No. 5,113,585 to Rogers et al. (against Doroodian's claims 1 and 2); and (4) Sensor® For Women cartridge (a commercial product, against Doroodian's claims 1 and 2).

28. The prior art asserted by Tseng against Doroodian for obviousness under 35 U.S.C. § 103 are: (1) U.S. Patent No. 3,879,844 to Griffith in view of U.S. Patent No. 2,703,451 to

(against Doroodian's claims 1-6); (4) U.S. Patent No. 5,113,585 to Rogers et al. in view of U.S. patent No. 2,703,451 to Hensel (against Doroodian's claims 1-6); and (5) Sensor® For Women in view of U.S. Patent No. 2,703,451 to Hensel (against Doroodian's claims 1-6).

29. Tseng's preliminary motion 5 is entitled: "TSENG CONTINGENT PRELIMINARY MOTION 5" and states the following:

> This motion only need be considered if Doroodian's anticipated motions based on no interference-in-fact and 35 U.S.C. § 135(b), as well as Tseng Preliminary Motions 2, 3 and 4 (based on invalidity under 35 U.S.C. § 112, first and second paragraphs), are all denied. In that event, Tseng requests consideration of this motion.

30. In its principal brief (Paper No. 86), party Tseng withdrew its still pending preliminary motions 2-4.

31. The only preliminary motion of party Tseng which still remains pending is Tseng's contingent preliminary motion 5.

Discussion

Party Tseng's preliminary motion 5 is contingent on a number of circumstances including the denial of Doroodian's preliminary motion 1 asserting no interference-in-fact. In Paper No. 85,

The parties should note that if our holding of no interference-in-fact is reversed upon judicial review, then the contingencies triggering consideration of Tseng's preliminary motion 5 will have to be reassessed upon return of the case to the board subsequent to judicial review.

Party Tseng has withdrawn its preliminary motions 2-4 (Finding 30). Consequently, those preliminary motions are no longer before us for consideration.

It is no longer necessary to decide whether, given our conclusion of no interference-in-fact, Tseng's preliminary motions 2-5 should be decided. Because any final hearing on issues decided by a 3-judge panel would be in the nature of a request for reconsideration, Charlton v. Rosenstein, No. 104,148, 2000 Pat. App. Lexis 4 (Bd. Pat. App. & Int. (Trial Section) 2000), and because neither party has requested reconsideration of our decision of October 16, 2001, we designate the panel decision of October 16, 2001 as final for purposes of judicial review.[3]

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[3] We recognize that Doroodian had filed a preliminary

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Judgment

It is

ORDERED that judgment as to the subject matter of the count is herein entered in favor of both junior party MINGCHIH M. TSENG and senior party SIAMAK DOROODIAN-SHOJA;

FURTHER ORDERED that on this record, junior party MINGCHIH M. TSENG is entitled to a patent containing its application claims 113, 117-123, 130-133, 135 and 136, but not application claim 134, which correspond to the count;

FURTHER ORDERED that on this record, senior party SIAMAK DOROODIAN-SHOJA is entitled to a patent containing its claims 1-6 which correspond to the count;

FURTHER ORDERED that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661; and

FURTHER ORDERED that a copy of this judgment will be entered as a paper in each party's involved application or patent.

RICHARD E. SCHAFER Administrative Patent Judge	
JAMESON LEE Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
RICHARD TORCZON Administrative Patent Judge	

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